

REMARKS/ARGUMENTS

Claims 1-12 were pending. In the present response, Applicants respond to the Examiner's arguments and have left claims 1-12 pending in the present application for the Examiner's consideration. No new matter has been added.

In summary of the Final Office Action of October 4, 2003, the Examiner has rejected claims 1-12 under 35 U.S.C. §103(a) as being unpatentable over Wang et al. (U.S. Patent No. 5,237,679) in view of Schmid et al. (U.S. Patent No. 5,569,164) and further in view of Khan et al. (U.S. Patent No. 6,401,206).

The Applicants respectfully traverse the Examiner's rejections.

I. The combination of Khan, Wang, and Schmid fails to disclose the claimed invention.

Claim 1, as amended, recites in part:

cryptographically securing the staple data object in response to receipt of the staple instruction, thereby indicating the existence of the association of selected pages and selected documents together at one time. (Emphasis Added).

Claim 9 recites a similar limitation. Applicants respectfully submit that the combination of Khan, Wang, and Schmid fails to disclose at least this element of the claimed invention.

The Applicants agree with the Examiner that neither Schmid nor Wang disclose any use of cryptography. (Office Action of January 13, 2003, p. 7). In the Office Action of October 4, 2003, the Examiner states that Khan teaches cryptographically securing the staple data object. (p.4). Applicants respectfully disagree with this assertion.

The Examiner cites column 11, lines 23-24 of Khan, as disclosing using cryptography to secure a set of documents. Reading the paragraph containing the cited portion of Khan in its entirety, Khan states:

FIG. 8 shows that the document (7002) is first concatenated with the public components of the digital identity (7001) and watermarks (7000) which now also carry a serial number (7003) and a random number or a universal time-stamp and positional information corresponding to a

particular impression (7004). The concatenation is then presented to the conventional cryptographic protocol discussed earlier. (Khan, col. 11, lines 26-34) (Emphasis Added).

As disclosed by Khan, the “concatenation” is comprised of “the document (7002)” and the public components of the “the digital identity (7001)” and “watermarks (7000).” “Document (7002)” of Khan refers to a single document and not a set of documents. Therefore, cited portion of Khan does not disclose a concatenation of multiple documents, but rather, the concatenation of a single document with a digital identity and watermark. Because Khan does not disclose cryptographically securing a set of documents, Khan cannot disclose “cryptographically securing the staple data object in response to receipt of the staple instruction, thereby indicating the existence of the association of selected pages and selected documents together at one time,” as recited by claim 1.

As neither Khan, Schmid, nor Wang disclose or suggest all of the elements of the claimed invention, Applicants respectfully submit that claim 1 and its dependent claims are patentable over the prior art. Applicants respectfully submit that claim 9, which recites similar elements, and its dependent claims are patentable over the prior art for similar reasons.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Appl. No. 09/302,552

PATENT

Amdt. dated January 30, 2004


Amendment under 37 CFR 1.116 Expedited Procedure

Examining Group

The Applicants invite the Examiner to contact the undersigned if the Examiner believes that a telephone conference would expedite prosecution of this application.

Respectfully submitted,

1/30/04
Date


Jonathan M. Hollander
Reg. No. 48,717

TOWNSEND and TOWNSEND and CREW LLP

Two Embarcadero Center, Eighth Floor

San Francisco, California 94111-3834

Tel: 415-576-0200

Fax: 415-576-0300

Attachments

JMH:gsh

60130446 v1